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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,312	11/06/2003	Yoshinori Sekine	F-8028	8003
28107 7590 06/25/2009 JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168				
EXAMINER				
DICUS, TAMRA				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
06/25/2009		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHINORI SEKINE

Appeal 2008-004003
Application 10/702,312
Technology Center 1700

Decided:¹ June 25, 2009

Before CHUNG K. PAK, CHARLES F. WARREN, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 12 in the Office Action mailed December 14, 2008. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R.

¹ The two month time period for filing an appeal or commencing a civil action specified in 37 C.F.R. § 1.304, begins to run from the Decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

§ 41.31(a) (2007).

We reverse the decision of the Primary Examiner.

Claim 1 illustrates Appellants' invention of an insert-molded article, and is representative of the claims on appeal:

1. An insert-molded article, comprising a film having transparency, a thermosetting decorative print layer printed by use of a crosslinking printing ink on the backside of said film for the purpose of visual observation from the front surface side of the film, a binder layer printed on said thermosoftening decorative print layer by use of a low-crosslinking printing ink or a non-crosslinking printing ink as the source of said binder layer, and a resin molded by injection on said binder layer.

The Examiner relies upon the evidence in these references (Ans. 3):²

Marentic	US 6,682,679 B1	Jan. 27, 2004
Ishikawa	US 6,933,044 B2	Aug. 23, 2005

Appellant requests review of the grounds of rejection under 35 U.S.C. § 102(e) advanced on appeal by the Examiner: claims 1 through 12 as anticipated by Ishikawa; claims 1 through 12 as anticipated by Marentic. App. Br. 3-4; Ans. 3 and 4.

We decide this appeal based on representative independent claim 1. See 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Issues

The issues in this appeal are whether Appellant has shown that the evidence in Ishikawa and in Marentic does not support the Examiner's findings of prima facie anticipation with respect to the claimed article encompassed by claim 1.

Claim Interpretation

² We consider these documents: Appeal Brief filed August 16, 2007; Examiner's Answer mailed November 14, 2007; and Reply Brief filed January 17, 2008.

The issues entail the interpretation of claim 1 by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the Specification unless another meaning is intended by Appellant as established therein, and without reading into the claims any disclosed limitation or particular embodiment. *See, e.g., In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), and cases cited therein; *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

The plain language of claim 1 specifies any insert molded article comprising at least the following layers in order, as illustrated in the embodiment depicted in Specification Figure 3 (Figure 3 numerals in parenthesis): (1) any transparent film; (2) any thermosoftening layer of any crosslinking printing ink “on the backside” of the transparent layer and visually observable through the transparent film; (3) a binder layer of any low- or non-crosslinking printing ink “on the thermosoftening layer;” and (5) any resin molded “on the binder layer.” *See* Spec. 15-19. The transitional term “comprising opens claim 1 to include articles that contain any number of additional layers of any manner of materials. *See, e.g., Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”).

Findings of Fact

We find Ishikawa would have disclosed to one of ordinary skill in this art the embodiments of a molded article depicted in Figure 4 in which metallic luster sheet 5 consists of the layers, in order: transparent sheet 2, metallic luster layer 3, first middle resin layer 7, and second middle resin layer 8. Ishikawa col. 5, ll. 60-67. Metallic luster layer 3 is formed on the reverse or backside of transparent sheet 2 by printing with luster producing ink. Ishikawa col. 6, ll. 6-10; *see also*, e.g., col. 4, ll. 27-65. First middle resin layer 7 is printed on metallic luster layer 3 with a cross-linking printing ink. Ishikawa col. 6, ll. 13; *see also* col. 6, ll. 1-2. Second middle resin layer 8 is printed on first middle resin layer 7 with a non- or low-crosslinking printing ink. Ishikawa col. 6, ll. 13-18; *see also* col. 6, ll. 2-5. A resin is mold injected on second middle resin layer 8. Ishikawa col. 6, ll. 28-32. “[D]irect contact between the injected melted resin . . . and the metallic luster layer 3 is prevented by the first and second middle resin layers 7 and 8,” such that “a luster-producing ink that forms the metallic luster layer 3 is not melted or removed by the heat and flow of the injected resin.” Ishikawa col. 6, ll. 32-37.

We find Marentic would have disclosed to one of ordinary skill in this art two molded product embodiments 26, 36 depicted in representative Figures 7 and 8, respectively, which are prepared by the process steps depicted in Figures 1-6. Marentic, e.g., col. 2, l. 18 to col. 3, l. 61. Figures 1 and 2 depict two different intermediate layer arrangements between release liner 18 and backing 12. Marentic col. 5, l. 59 to col. 6, l. 12; *see also*, e.g., col. 2, ll. 18-22. In Figure 1, decorative transfer 10 has first intermediate layer 14 which is an ink film in a desired image formed on backing 12, and second intermediate layer 16 which includes a tacky resin, preferably a

tacky, clear gel coat layer, formed on first intermediate 14. Marentic col. 5, l. 59 to col. 6, l. 4; *see also*, e.g., col. 2, ll. 22-24, and col. 3, ll. 31-40. In Figure 2, decorative transfer 30 has single intermediate layer 32 which includes an ink film in a desired image and a tacky resin formed on backing 12. Marentic col. 6, ll. 5-12; *see also*, e.g., col. 2, ll. 24-27, and col. 3, ll. 25-30. In Figures 3 and 4, the respective tacky intermediate layers 16 and 32 of decorative transfers 10 and 30 are placed against a mold surface and backing layers 12 removed. Marentic col. 11, l. 66 to col. 12, l. 18. In Figures 5 and 6, a catalyzed, crosslinking colored gel coat 22 is applied to respective intermediate layers 14 and 32, and molded support resin material 24 is applied to colored gel coat layers 22. Marentic col. 14, ll. 42-56; *see also*, e.g., col. 2, ll. 31-38. “The co-crosslinking of the polymers in all the layers . . . forms a monolithic-type structure with an image that is particularly durable due to protection afforded by the crosslinked clear outer gel coat.” Marentic col. 15, ll. 6-13; *see also*, e.g., col. 2, ll. 39-44, and col. 14, ll. 57-65.

In Figure 7, molded product 26 has clear gel coat layer 16, intermediate layer 14³ that includes an ink film, colored gel coat layer 22, and molded structure 24. Marentic col. 16, ll. 6-12; *see also*, e.g., col. 2, ll. 53-57. “[T]he image of a decorative transfer is covered by and visible through an outer layer of crosslinked polymers derived from clear gel coat.” Marentic col. 2, ll. 45-49. In Figure 8, molded product 36 has the crosslinked image of intermediate layer 32, colored gel coat layer 22, and molded structure 24. Marentic col. 16, ll. 19-21. “The image, in this

³ Numeral “12” appearing in Figure 7 is in error as seen from Figures 1, 3, and 5.

embodiment, is the crosslinked outer layer.” Marentic col. 16, ll. 22-23; *see also*, e.g., col. 2, ll. 49-52.

Marentic discloses that “other types of intermediate layers and/or more than two layers are also contemplated,” and where more than two intermediate layers are present, the upper most intermediate layer includes a tacky resin and the first intermediate layer includes a tack-free resin. Marentic col. 3, ll. 62-67; *see also*, e.g., col. 3, ll. 7-11 and 41-47, col. 5, ll. 23-28.

Discussion

We considered the totality of the record in light of Appellants’ arguments with respect to claim 1 and the ground of rejection advanced on Appeal. *See, e.g., In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.”) (citing, *inter alia*, *In re Spada*, 911 F.2d 705, 707 n.3 (Fed. Cir. 1990)).

The Examiner must establish a *prima facie* case of anticipation under § 102(e) by showing, as a matter of fact, that a single reference describes to one skilled in this art each and every limitation of the claimed invention encompassed by the claim, arranged as required therein, either explicitly or inherently. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997),

and cases cited therein; *In re Bond*, 910 F.2d 831, 832-33 (Fed. Cir. 1990), and cases cited therein.

Ishikawa: Claim 1

We determine Appellant has established the evidence in Ishikawa does not support the Examiner's finding of prima facie anticipation with respect to the claimed article encompassed by claim 1. We agree with Appellant's position that the embodiment described in Ishikawa's Figure 4, relied on by the Examiner, does not anticipate claim 1. Reply Br. 4-7; Ans. 4 and 5-6. As Appellant points out, claim 1 requires that the thermosoftening layer is a crosslinked printing ink on the back of the transparent film layer and visually observable through the transparent film layer. *See above* p. 3; Reply Br. 5. Indeed, as Appellant submits, in Ishikawa's Figure 4, cross-linked resin layer 7 is not next to transparent layer 2 and is hidden from view through transparent layer 2 by metallic layer 3. Reply Br. 6; *see above* p. 4.

Accordingly, in the absence of a prima facie case of anticipation over Ishikawa, we reverse the ground of rejection of claims 1 through 12 under 35 U.S.C. § 102(e).

Marentic: Claim 1

We determine Appellant has established the evidence in Marentic does not support the Examiner's finding of prima facie anticipation with respect to the claimed article encompassed by claim 1. We agree with Appellant that the embodiments described in Marentic's Figures 1-8 do not anticipate claim 1. Reply Br. 9. As Appellant points out, claim 1 requires that the binder layer is a low- or non-crosslinking printing ink on the thermosoftening layer and the described embodiments do not contain this

layer. *See above* p. 3; Reply Br. 9. In this respect, we agree with Appellant that in Marentic's described embodiments, the colored gelcoat layer is not a binder layer as claimed since it is not a low- or non-crosslinking ink layer. Reply Br. 11; *see above* pp. 5-6. We further agree with Appellant that contrary to the Examiner's contentions, Marentic's general disclosure of alternative embodiments wherein one or more additional intermediate layers of unspecified ingredients can be present in the molded product does not provide a description of a molded product. Indeed, to arrive at the claimed articles having a binder layer as claimed, one skilled in this art would have to pick and choose between unrelated embodiments. Reply Br. 9-10; Ans., e.g., 4-5, 7, and 8; *see above* p. 6. *Cf. In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) ("[F]or the instant rejection under 35 U.S.C. 102(e) to have been proper, the . . . reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference."). In this respect, we note Appellant also points out that the colored gelcoat layer does not fall within Marentic's description of "intermediate layers." Reply Br. 11; *see above* pp. 5-6.

Accordingly, in the absence of a prima face case of anticipation over Marentic, we reverse the ground of rejection of claims 1 through 12 under 35 U.S.C. § 102(e).

The Primary Examiner's decision is reversed.

Appeal 2008-004003
Application 10/702,312

REVERSED

tc

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